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EXAMINER

BROWN, TIMOTHY M

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1648

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/874,010

Applicant(s)

NAKAGAWA, SHIGEHARU

Examiner

Tim Brown

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 38-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 38-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This Final Office Action is responsive to Applicant's Amendment submitted December December 1, 2003. Amendments to the claims have been entered. New claims 38-75 have been entered and examined.

Response to Arguments

35 U.S.C. Sec. 102

Claims 1, 2 and 10 (now presented as claims 45, 46 and 54)

Applicant argues Farros fails to teach his editor. In particular, Applicant suggests there is no teaching of a division of labor wherein the publication and preparation of a document is bifurcated. The Examiner respectfully disagrees.

First, the claims fail to separate the preparation and publication of a document. Claim 45 for example recites "said printing agency comprising an editor connected to said memory to edit said first draft of said print job to create a first revision." The first revision could exist in a computer readable form without being reduced to a tangible medium. Having no division of the preparation and publication of a document, Farros need not teach this feature to support a 102 rejection.

Second, Farros teaches the claimed editor. As noted previously, "edit" is defined as to prepare for publication. Thus, a fair reading of the claims reveals Applicant's editor is directed to computer programming that prepares a document for printing. Such an interpretation is consistent with Applicant's own disclosure which provides the editor merely "changes a draft copy of the document provided by the user." (Paper No. 17, p 2). Farros teaches this editor

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through its disclosure of a production system located at a remote printing facility which “decrypts and expands the received files to the extent necessary” for printing (col. 5, lines 33-37). Furthermore, Farros manipulates the form data (user-identified text and print job attributes) to produce a final version of the desired print job. Accordingly, Farros teaches Applicant’s editor.

Applicant argues Farros does not teach “storing editing programming on a Website server.” However, this argument is moot in that none of claims 45, 46 and 54 recites this limitation.

Applicant argues Farros does not teach “a homepage that can be accessed by a customer’ with Applicant’s ‘editor’ and ‘output device’ in combination.” First, the Examiner notes Farros teaches Applicant’s editor as noted above. Second, Farros teaches an output device through its disclosure of a plurality of remotely located printing facilities each having a combination of monitors and printers (*see e.g.* abstract, lines 13-14; col. 5, lines 33-36). Third, Farros teaches “a homepage that can be accessed by a customer” through its client/server application. This client server application consists of program module 206 which communicates with remotely located client computer 302 over Internet connection 403 (*see e.g.* col. 7, lines 11-50). Program module 206 generates a graphical interface upon being queried by client computer 302 (*Id.*, *see also* Fig. 5). This graphical interface constitutes a homepage because it generated in a client/server environment over the Internet. Based on the foregoing, Farros teaches “a homepage that can be accessed by a customer’ with Applicant’s ‘editor’ and ‘output device’ in combination.”

Applicant argues the Examiner has confused his editor with Applicant’s output device. Applicants point to a passage in Farros cited by the Examiner. This passage (col. 8, liners 48-54)

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describes how a customer is presented with a change screen which permits a customer to make any changes to his print order. While Applicant has pointed out editing by the customer, he has ignored the editing that is electronically performed by Farros' remote printing facility. As noted above, Farros' remote printing facility prepares the customer's order for publication prior to printing. Thus, the Examiner has acknowledged the distinction between Applicant's editor and his output device.

Applicant argues Farros cannot anticipate his invention because it is directed to "novelty printing." According to Applicant, "novelty printing" relates to a printing service wherein users navigate a series of forms to develop products having unique characteristics such as the misspelling of words such as IBM's "THINK" slogan. A careful reading of Farros however fails to reveal the term "novelty printing" or any other text that could support such an interpretation of Farros. Accordingly, Applicant's argument is moot.

With respect to claim 2 (now claim 46), Applicant makes two points. First, Applicant argues Farros fails to teach a first and finalized draft. Second, Applicant argues Farros fails to teach a print job comprising text, images and pictures. Applicant's second argument is moot in view of the new grounds of rejection discussed *infra*. With respect to Applicant's first argument, the Examiner notes Farros teaches at least a first draft by storing an open print order (see e.g. Fig. 7, char. 706). The Examiner further notes Farros teaches a finalized version through its disclosure of providing customers with a finalized printed. Accordingly, Farros teaches a first and finalized draft.

With respect to claim 10, Applicant argues Farros does not teach production of a manuscript and/or document. The Examiner submits Farros teaches this feature through its

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disclosure of printing items including business cards and letterhead. Applicant also argues the Examiner has misconstrued claim 10 by interpreting the claims as defining the editor and output device as a single unit. However, as noted above, the Examiner's discussion of the claims acknowledges Applicant's editor and output device are separate features.

Applicants argue Farros can not anticipate claims 45 and 54 because Farros' programs and storage reside on the customer computer. The Examiner respectfully disagrees and directs Applicants to column 7, lines 24-30 which provides that the programming and data storage required for implementing the print service may reside on a remote client server. Accordingly, Farros' teachings are not restricted to programs and storage residing strictly on a customer computer.

Claims 3-8, 11-13, 16-18 & 25-27 (now presented as claims 47-52, 55-57, 60-62 & 69-71)

With respect to claim 11, Applicant requests that clarification be provided as to (1) the differences between the subject matter sought to be patented and the prior art, (2) the combination of teachings when taken as a whole render Applicant's invention obvious, and (3) that the Examiner submit an affidavit to support the assertion of Official Notice.

In response to the first two requests, the Examiner maintains the Office Action clearly pointed out the teachings of the cited references. Applicant is kindly directed to pages 11 and 12 of Paper No. 11. In response to Applicant's third request, the Examiner notes Official Notice was taken that "editing a customer's print job at a print agency connected to the customer via the Internet is old and well known in the art." The Examiner further notes Official Notice of this

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limitation was taken in Paper No. 6, page 7. However, Applicant failed to timely request documentary evidence in support of the Official Notice in his reply (Paper No. 9). The Official Notice is therefore admitted prior art in accordance with MPEP §2144.03.

Applicant further argues the combination of claimed limitations is not old and well known in the art. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues Farros lacks any teaching or suggestion of issuing a cost estimate and receiving a first draft of a customer's printing job. The Examiner notes Farros need not teach this limitation inasmuch Official Notice was offered for this limitation.¹ Furthermore, Farros suggests combining its service with the issuance of an online estimate since this would provide a means for providing customers printing service costs *ab initio*. Applicant admits the desirability of this combination by noting that Farros is "difficult and cumbersome" when it comes to providing customers with a service cost. Accordingly, Farros suggests incorporating the well-known concept of issuing an online cost estimate.

Applicant argues Farros lacks any teaching of a printing agency. However, Farros teaches this limitation through its disclosure of "a remotely located printing facility" (abstract, line 14). Applicant also charges Farros does not teach an Internet connection. However, Farros provides that customers may access the online printing service through a personal computer having Internet access (col. 7, lines 7-10).

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Applicant argues Farros and Official Notice fail to teach receiving an online estimate in the context of claim 55. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant argues Farros fails to teach the editor of claim 55. However, the Examiner submits Farros teaches this feature as noted *supra*.

Applicant argues Farros cannot teach the editor in Applicant's claims because (1) the editor needs to be both "knowledgeable of editing skills that were in existence before the computers" and computer software, and (2) that the customer does not have these skills because the customer does not specialize in these areas. However, this argument makes a large assumption that is in no way supported by the claim language. Accordingly, Applicant's point is moot.

Claims 58 & 59 (now presented as claims 14 and 15)

Applicant argues the Examiner's failure to address the limitation of editing at the print agency to correct misspellings, typographical errors, and other errors that result from differences in computer software indicates that an editor at a print agency is not old and well known. However, the Examiner Chabrow was offered for teaching this feature. Accordingly, Applicant's argument is moot.

¹ The Examiner notes Applicant has failed to request documentary evidence for the Official Notice taken in the

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Claim 60

Applicant argues editing done in an Internet electronic environment is not old and well known. However, the Examiner notes Official Notice was not take for editing in an Internet electronic environment. Accordingly, Applicant's argument is moot.

Claim 61

Applicant argues Farros does not relate to an internet print service. However, Farros teaches this limitation as noted above. Applicant further charges that there is no motivation to combine Farros with the features of claim 61 because Farros provides that it is the user, and user alone that performs the steps of editing. First, the Examiner notes Farros automatically performs editing as noted above. Furthermore, the fact that the customer is *permitted* to edit his print order does teach away from having the auxiliary function taught by Chabrow. Farros is directed to printing documents such as letterhead and business cards. It is hard to imagine that a customer purchasing these items would not want an additional layer of editing in order to prevent typographical errors in one's title such as "atorney at law." Accordingly, Farros does not teach away from Chabrow's editing features.

Claims 20 & 24 (now presented as claims 64 & 68)

Applicant argues the combination of Farros and Chabrow fail to teach an editor at the place where the customer submits the document for printing services. The Examiner submits Farros teaches Applicant's editor as noted above.

previous Office Action (Paper No. 11). Accordingly, this, and all other instances of Official Notice for which

Claims 9, 14, 15 & 19 (now presented as claims 53, 58, 59 & 63)

Applicants argue there is no motivation to combine Farros with Chabrow's teaching of correcting misspellings, typographical errors and unreadable characters. Applicants point to their comments with respect to the "novelty printing" industry as noted above in asserting the proposed combination is impractical. However, as noted above, it would be desirable to modify Farros to correct misspellings and typographical errors in order to instill quality in the production of printed products. Even if Farros could be construed to teach a novelty printing system, combining its teachings with the correction of typographical errors would not render Farros inoperable for such a purpose since users are given an opportunity to approve a final draft (*see* col. 5, lines 10-11). Accordingly, the combination of Farros and Chabrow is proper.

Claims 28 & 29 (now presented as claims 72 & 73)

Applicant argues that like Farros, Chabrow is directed to the whimsical "novelty printing industry." However, as with Farros, the Examiner submits Chabrow does not make any reference to any such service. Thus, Applicant's argument is moot. Moreover, it is hard to imagine any customer would want to intentionally insert typographical errors in a professional document such as a check or business card (*see* Chabrow, p. 1).

Claim 30 (now presented as claim 74)

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Applicant argues neither Chabrow, PR Newswire nor Official Notice teach any editor other than the customer. The Examiner respectfully submits PR Newswire teaches this feature. PR Newswire teaches a technical standard that permits users to save and manage documents on the web. The standard permits users to remotely collaborate to edit a single document. Because a plurality of users edit a single document, an individual other than the author is permitted to edit the author's document. Accordingly, PR Newswire teaches an editor other than the customer.

Claims 31-37 (now presented as claims 75-81)

Applicant argues Chabrow that the combination of Chabrow, PR Newswire and Goldberg fails to teach having a someone other than the user perform the first editing. However, PR Newswire teaches this feature as noted above.

Claims 38 & 39

Applicant argues the modifying Golderg to include Chabrow's teaching of editing by one other than the user would destroy the intended mode of operation of Goldberg. Applicant asserts the mode of operation of Goldberg is to have editing performed solely by the user. The Examiner respectfully disagrees. First, the mode of operation of Goldberg is to provide a customized, edited, embroidered product. The Examiner's proposed combination of having another perform the editing would not destroy this function. In fact, such a combination would provide a means for incorporating the stylistic input of others. Second, Goldberg does not provide the customer with the exclusive level of editing suggested by the Applicant. This is clear from the fact that editing by the customer is controlled by Java programming which limits

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the changes the user may make (*see* col. 4, lines 18-31). For at least these two reasons, incorporating a feature wherein editing by one other than the user does not destroy the intended mode of operation of Goldberg.

Applicant has requested documentary evidence in support of the Official Notice taken with respect to (1) the use of a password for accessing a customer's estimate, and (2) storing customer order profile information on a remote database. In support of the first limitation, the Examiner offers Chronister (Chronister, K. "Site Designed to Simplify Quote Process" Electronic Buyer's News (March 31, 1997) p. 76). As to the second limitation, the Examiner cites U.S. Patent No. 6,035,288 to Solomon (*see e.g.* col. 4, lines 1-32).

Claims 39-42 & 44

With respect to claim 39, Applicant argues modifying Golderber to correct spelling would impermissibly destroy the intended mode of operation of Goldberg. However, the Examiner notes the intended mode of operation of Goldberg is to provide users with an embroidered product in an online environment. The Examiner submits a process wherein errors such as misspellings would not destroy the intended mode of operation of Goldberg. In fact, Goldberg is replete with teachings that relate to editing. Accordingly, modifying Goldberg to provide for the correction of misspellings would not destroy the intended mode of operation of Goldberg.

With respect to claim 40, Applicant requests documentary evidence in support of the Official Notice taken that "selecting a service provider based on their geographical location is

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old and well known in the art.” The Examiner cites US Patent No. 5,991,739 in support of this limitation.

With respect to claim 41, Applicant argues the combination of Goldberg and PR Newswire would destroy the intended mode of operation of Goldberg. However, as noted above, the Examiner submits that modifying Goldberg to include a limitation wherein editing is performed by one other than the customer would provide for the creative input of others. Moreover, PR Newswire’s teachings would enhance product quality by correcting errors, and or sizing problems relating to the user’s selected modification and the size of the medium for customization. Accordingly, the combination of Goldberg and PR Newswire does not destroy the intended mode of operation of Goldberg.

With respect to claim 44, Applicant asserts the Official Notice of attributes such as the number of pages, the number of copies, and the type of binding does not overcome the deficiencies of the prior art. However, the Examiner notes that by asserting these limitations, the very limitation recited in claim 44, are old and well known, the Examiner expressly overcomes any purported deficiencies in the prior art. Moreover, in failing to request documentary evidence in support of the Official Notice taken, Applicant admits these features are old and well known (*see* MPEP §2144.03).

Allowance of Claim 43

Applicant asserts claim 43 is allowable in that the Examiner failed to reject this claim in the previous Office Action. However, a careful reading of the Office Action reveals this claim was rejected on pages 29 and 30. Accordingly, claim 43 is not allowable.

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 38-44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Goldberg, in view of PR Newswire, Chabrow and Official Notice.

Regarding claim 38, Goldberg teaches an apparatus for printing, the apparatus comprising:

a server with a corresponding home page accessible through the Internet, said server receiving a cost request through the Internet from a user, the cost request including a request for an estimate of a cost of a job and including identification data corresponding to the user, the cost request including first data about the job;

said server sending a cost estimate through the Internet to a destination corresponding to the identification data, the cost estimate being generated in dependence upon the received cost request, the cost estimate including the estimate of the cost of the job, said server receiving the print data through the Internet from the user when the user receives and approves the cost estimate, the print data being the information to be recorded on recordable media (Abstract; col. 5, lines 25-30).

Goldberg does not expressly teach providing a cost estimate for a printing job. However, the Examiner notes it would have been obvious to modify Goldberg to provide cost estimates for printing jobs in order to expand the scope of application of Goldberg.

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Goldberg does not expressly teach providing a customized good comprising a printed product. However, because Golberg provides cost estimates for customized products, it would have been obvious to apply Golberg to the providing of cost estimates for printed products.

Goldberg does not expressly teach an editing unit being in communication with said server, said editing unit editing the print data received by said server through the Internet from the user when the print data is not in a final form, said editing unit being distinguishable from the user. However, PR Newswire teaches a system for collaboratively editing documents over the Internet. At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Goldberg to include the teachings of PR Newswire because including an editor at said printing agency having access to software and hardware to monitor, evaluate and modify said document created by said customer at said user terminal and to store said modified document in a second memory at said printing agency would enable the customer to improve the quality of their documents.

The combination of Goldberg and PR Newswire does not teach a second memory unit storing the print data when the print data is in the final form, said second memory unit being in communication with said editing unit; and an output device receiving the print data in the final form from said second memory unit, and recording the print data in the final form on the recordable media. However, Chabrow teaches a system for providing customized print products over the Internet wherein customers' print parameters are stored on a variety of tangible media. At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Golberg and PR Newswire to include a second memory unit storing the print data when the print data is in the final form, said second memory unit being in communication with

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said editing unit; and an output device receiving the print data in the final form from said second memory unit, and recording the print data in the final form on the recordable media in order to store customer's custom order parameters, and then reduce the order to its tangible requested form.

The Examiner takes Official Notice that the use of a password for accessing the customer's estimate is old and well known in the art. Therefore, at the time of Applicant's invention, it would have been obvious to modify Goldberg, PR Newswire and Chabrow to include the use of a password in order to provide security to the customer's order information.

The Examiner also takes Official Notice of the fact that storing customer order profile information on a remote database is old and well known in the art. Therefore, at the time of Applicant's invention, it would have been obvious to modify Goldberg, PR Newswire and Chabrow to include a first memory unit storing the cost request and the identification data received from said server, said first memory unit being in communication with said server. This combination would enable customers to access their information at a later date.

Regarding claim 39, Goldberg, Chabrow, PR Newswire and Official Notice teach all the limitations discussed under claim 38. Goldberg, Chabrow and PR Newswire do not expressly teach the identification data corresponding to an e-mail address of the user. However, the Examiner takes Official Notice that providing a customer contact information, including an e-mail address, is old and well known in the art. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Goldberg, Chabrow and PR Newswire to include the identification data corresponding to an e-mail address of the user in order to provide a convenient means for contacting customers.

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Regarding claim 40, Goldberg, Chabrow, PR Newswire and Official Notice teach all the limitations discussed under claim 39. Goldberg, PR Newswire and Official Notice do not teach said output device corresponding to a selected output device selected from among a plurality of available output devices, said output device receiving the print data through the Internet from said second memory unit. However, Chabrow teaches transmitting a print order from a printing service to a remotely located printing facility. At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Goldberg, PR Newswire and Official Notice to include the teachings of Chabrow in order to outsource printing jobs when special printing needs are required.

The Examiner takes Official Notice of the fact that selecting a service provider based on their geographical location is old and well known in the art. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Goldberg, Chabrow and PR Newswire to include selecting the output device geographically nearest to the user. This would provide the user with the most convenient pick-up location.

Regarding claim 41, Goldberg, Chabrow, PR Newsire and Official Notice teach all the limitations discussed under claim 38. Goldberg, Chabrow and Official Notice do not expressly teach said server sending the edited print data through the Internet to the user after said editing unit performs the editing of the print data, the user receiving the edited data through the Internet and revising the edited print data and sending the revised print data to said server, said editing unit further revising the revised print data received by said server from the user to place the revised print data in the final form. However, PR Newswire teaches a system for collaboratively editing documents over the Internet. At the time of Applicants' invention, it would have been

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obvious to one of ordinary skill in the art, to modify Goldberg, Chabrow and Official Notice to include the teachings of PR Newswire because this would enable the customer to improve the quality of his documents.

Regarding claim 42, Golberg teaches said editing unit generating the cost estimate (Abstract).

Regarding claim 43, Goldberg, Chabrow, PR Newswire and Official Notice teach all the limitations discussed under claim 38. Goldberg, Chabrow and Official Notice do not expressly teach said server sending the edited print data through the Internet to the user after said editing unit performs the editing of the print data, the user receiving the edited data through the Internet and revising the edited print data and sending the revised print data to said server, said editing unit further revising the revised print data received by said server from the user to place the revised print data in the final form. However, PR Newswire teaches a system for collaboratively editing documents over the Internet. At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Goldberg, Chabrow and Official Notice to include the teachings of PR Newswire because including an editor at said printing agency having access to software and hardware to monitor, evaluate and modify said document created by said customer at said user terminal and to store said modified document in a second memory at said printing agency would enable the customer to improve the quality of their documents.

Regarding claim 44, Goldberg, Chabrow, PR Newswire and Official Notice teach all the limitations discussed under claim 38. Chabrow further teaches the cost request including a name of the user, the printing location, and a type of recordable media of the print job. Goldberg, Chabrow and PR Newswire do not expressly teach, a number of pages of the print job, a number

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of copies of the print job, a type of binding of the print job. However, the Examiner takes Official Notice that these are common parameters that are indicated by a customer when ordering a print job. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Goldberg, Chabrow and PR Newswire to include a number of pages of the print job, a number of copies of the print job, a type of binding of the print job in order to enable customers to provide complete order information.

Claims 45, 46, 52, 54 and 71 are rejected under 35 U.S.C. 103(a) as being obvious over Farros in view of Goldberg and PR Newswire.

Regarding claim 45, Farros teaches an Internet printing apparatus, comprising:

a printing agency, comprising a server disseminating a home page that, in response to an inquiry by a customer over the World Wide Web, provides instructions explaining how a customer can request a print job, and enables a customer to select and to modify attributes of said print job, said home page, said home page further comprising a form that may be accessed through a hyperlink, said form enabling a customer to request said print job of a first draft received from the customer (col. 2, lines 24-27 and 51-55; col. 4, lines 27-30; col. 7, lines 46-51 and 53-65; and col. 8, lines 15-17);

said printing agency comprising a memory storing a customer's choice of attributes for said print job and, storing a first draft of said print job and that is received from the customer via the World Wide Web (col. 5, lines 14-20);

said printing agency comprising an editor connected to said memory to edit said first draft of said print job to create a first revision of said first draft (col. 8, lines 30-36 and 42-67; Fig. 4);

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said memory being connected to said editor storing said finalized version of said print job (col. 11, lines 45-52); and

an output device connected to said second memory via network printing to download said finalized version onto a recording media at a location that is geographically compatible with the customer's choice (col. 2, lines 27-32).

Farros does not expressly teach "an estimation of cost" and "subsequent to delivery of said estimation." However, Goldberg teaches a method of providing a customized product to a user over the Internet, including the steps of receiving a request for a quote and transmitting a cost estimate to the user in response to the request (Abstract; and col. 5, lines 25-27). At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Farros to include the teachings of Goldberg in order to provide customers with an estimated cost for their custom print job. Thus, customers would be permitted to compare vendors according to price.

Farros and Goldberg do not expressly teach "to enable said customer to receive said first revision via the World Wide Web, and to receive from the customer via the World Wide Web, a second draft prepared by the customer in dependence upon said first revision, and to generate a finalized version in dependence upon said second draft." However, PR Newswire teaches a system for collaboratively editing documents over the Internet. At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Farros to include the teachings of PR Newswire because including an editor at said printing agency having access to software and hardware to monitor, evaluate and modify said document created by said

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customer at said user terminal and to store said modified document in a second memory at said printing agency would enable the customer to improve the quality of their documents.

Regarding claim 46, Farros teach an apparatus wherein said customer's first draft and said finalized version of said customer's print job comprises text, images and pictures (col. 3, lines 66-67; col. 4, lines 1-10; and col. 8, lines 58-60).

Regarding claim 52, Farros teach an Internet printing apparatus wherein editing comprises changes made by said editor to said first draft submitted by said customer over said Internet to said first memory, said changes include changes specified by said customer and changes initiated by said editor (Abstract; and col. 8, lines 30-36 and 42-50).

Regarding claim 54, Farros teaches an output device that is reasonably capable of printing 180 sheets per minute (col. 2, lines 27-32).

Regarding claim 71, Farros teaches said editor having access to apparatus for monitoring and modifying text and images submitted by said customer to said editor over the world wide web (col. 2, lines 25-34).

Claims 47-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Farros in view Goldberg, PR Newswire and Official Notice.

Regarding claim 47, Farros teach all the limitations discussed under claim 45 above. Farros further teaches an Internet printing apparatus wherein said printing parameters comprise: size of paper to be printed on (col. 4, lines 27-30; col. 8, lines 25-27; and col. 9, lines 4-6); color of paper to be printed on (col. 9, lines 2-4; and col. 10, lines 57-60) quality of paper to be printed on (col. 9, lines 4-6) and col. 10, lines 57-60); quantity to be printed (col. 10, lines 41-43); and type and location of output device (col. 10, lines 57-60; and col. 11, lines 14-19 and 54-61).

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Farros does not teach an Internet printing apparatus wherein said printing parameters comprise whether or not to print a finished cover page and whether or not to bind each document printed and a type of binding to be used. However, the examiner takes Official Notice that determining whether or not to include a cover page and the type of binding to be used for a print job is old and well known in the art. Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify the system of Farros to include accepting printing parameters comprising whether or not to print a finished cover page and whether or not to bind each document printed and a type of binding to be used. This modification would permit the user to customize his print job and provide for a bound print product with pages collectively attached such that their order is maintained.

Regarding claims 48-51, Farros, Goldberg and PR Newswire teach all the limitations discussed under claim 45 above. Farros, Goldberg and PR Newswire do not teach an Internet printing apparatus further comprised of said output device being selected from the group consisting of a toner type digital printer, a CD-ROM printing device, an ink jet type printer and a magnetic optical disk read/write device. However, the examiner takes Official Notice that these output devices are old and well known in the art. Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Farros, Goldberg and PR Newswire to include an output device selected from the group consisting of a toner type digital printer, a CD-ROM printing device, an ink jet type printer and a magnetic optical disk read/write device. Such a modification would provide at least two benefits. First, the user would be afforded a range of quality for his print job. Second, the user could select a format for his print job that is compatible with his personal system.

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Regarding claim 63, Farros, Official Notice and PR Newswire teach all the limitations discussed under claim 55 above. Farros further teaches an output device located at a second location distant from said printing agency (Abstract; col. 10, lines 41-46), said output device being connected by network printing to said second memory of said printing agency that stores said document for output (col. 11, lines 7-11 and 45-52). Farros, Official Notice and PR Newswire do not expressly teach a plurality of output devices located at a second plurality of locations distant from said printing agency. However, Chabrow teaches transmitting print orders to a plurality of commercial printers over the Internet. At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Farros, PR Newswire and Official Notice with the teachings of Chabrow because the addition of a plurality of output devices located at a second plurality of locations distant from said printing agency would enable the printing agency to select from a number of print service providers. This would allow the printing agency to select a print service provider that offers the lowest cost or the shortest lead time. This modification would also afford the printing agency a wider range of options for locating a print service provider that is capable of filling specialized or high-volume orders.

Claims 64, 66, 72 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chabrow in view of PR Newswire

Regarding claim 64, Chabrow teaches a system for printing a document having text, images and pictures, comprising:

a printing agency comprising a server accessible via the Internet, said server providing a port accomodating transmission of information between said printing agency and computers of users accessing the Internet (page 1, paragraph 1);

a manuscript composed by a corresponding one of the users with at least one of text, image and pictoral components and submitted by the corresponding one of the users to said printing agency to produce the document (page 1, paragraph 1); and

a first of a plurality of output devices located at a second plurality of locations distant from said printing agency, each of said first plurality of output devices connected to said printing agency via a computer printing network (page 1, paragraph 4).

Chabrow does not expressly teach "said printing agency comprising an editor" and "said printing agency returning a first draft of said document to the corresponding one of the users, and disposed to generate a final draft of said document in response to reception of a revision of said first draft from the corresponding one of the users." However, PR Newswire teaches a system for collaboratively editing documents over the Internet. At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Farros to include the teachings of PR Newswire would enable the printing agency to provide an additional layer of service wherein the customer and printing agency collaborate to correct any print job errors that may be detected by the print agency.

Chabrow does not expressly teach "independently of said printing agency." However, PR Newswire overcomes this deficiency through its disclosure of posting original documents on a network-accessible database. At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Farros and Official Notice to include the teachings of

PR Newswire as this combination would enable Farros to provide a greater variety of print products since the customers' selection would not be limited to pre-existing forms.

Regarding claim 66, Chabrow further teaches a system for printing a document having text, images and pictures wherein a second plurality of users are transmitting and receiving data and revisions of a plurality of manuscripts simultaneously from said printing agency (page 1, paragraph 3).

Regarding claim 72, Chabrow teaches a system comprising:

a printing agency having a web page accessible by a plurality of customers via the Internet, enabling the customers to specify attributes for manufacturing a publication of a document created by the customer (p. 1);

a plurality of output devices located at a corresponding plurality of locales distant from said print agency, each of said plurality of output devices connected to said print agency by a computer printing network, each of said plurality of devices selectably used by the user to manufacture the publication based upon the revised document (p. 1).

Chabrow does not expressly teach "an editor at said printing agency receiving the document from the user, and then monitoring, evaluating and modifying the document created by said customer, storing a modification of the document in a second memory at said printing agency, returning the modification to the customer via the Internet, and enabling the customer to revise said modification and return a revised document to said printing agency via the Internet." However, PR Newswire teaches a system for collaboratively editing documents over the Internet. At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow to include the teachings of PR Newswire. This combination of teachings

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would provide an additional layer of service wherein the customer and printing agency collaborate to correct any print job errors that may be detected by the print agency.

Regarding claim 73, Chabrow teaches said print information comprising the number of copies to be printed and the media to be printed during said manufacturing (p. 1).

Claims 65 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chabrow in view of PR Newswire and Farros.

Regarding claim 65, Chabrow and PR Newswire teach all the limitations discussed under claim 64 above. Chabrow and PR Newswire do not teach a system for printing a document having text, images and pictures wherein said printing agency comprises: a first memory for storing a manuscript originally submitted by said user prior to editing; and a second memory for storing said finalized document after editing. However, Farros teach creating an electronic file for a draft of a print product and saving a finalized version of the print product on a second storage medium (col. 5, lines 9-20; and col. 11, lines 45-52). At the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow and PR Newswire to include the teachings of Farros. A first memory for storing a manuscript originally submitted by said user prior to editing would permit a user to return to a previous print job to make revisions. A second memory for storing said finalized document after editing would provide a means for transmitting the finalized document to the printing agency thereby making it possible to process the order on multiple occasions without requiring the user to resubmit a product order.

Regarding claim 68, Chabrow and PR Newswire teach all the limitations discussed under claim 64 above. Chabrow does not teach a system for printing a document having text, images and pictures wherein said first plurality of output devices print at a rate of 180 sheets per minute. The examiner notes that the limitation “wherein said output device prints 180 sheets per minute” is functional claim language and carries little weight because it does not provide any physical limitation. Moreover, Farros teach an output device that is reasonably capable of printing 180 sheets per minute (col. 2, lines 27-32). Therefore, at the time of the applicant’s invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow and PR Newswire to include the teachings of Farros in order to obtain high volume output in order to decrease service lead time.

Claims 67 and 74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chabrow in view of PR Newswire and Official Notice.

Regarding claim 67, Chabrow and PR Newswire teach all the limitations discussed under claim 64 above. Chabrow and PR Newswire do not teach a system for printing a document having text, images and pictures wherein said first plurality of output devices comprise: toner type digital printers; CD-ROM printing devices; ink jet type printers; and magnetic optical disk read/write devices. However, the examiner takes Official Notice that these output devices are old and well known in the art and are commonly used in connection with a personal computer. Farros suggest combining its system with an output device comprising a toner type digital printer, a CD-ROM printing device, an ink jet printer or a magnetic optical disk read/write device in that Farros disclose that its method can be implemented using a personal computer with

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Internet access (col. 2, lines 42-46). Therefore, at the time of the applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow and PR Newswire to include output device comprising a toner type digital printer, a CD-ROM printing device, an ink jet printer or a magnetic optical disk read/write device.

Regarding claim 74, Chabrow and PR Newswire teach all the limitations discussed under claim 72. Chabrow and PR Newswire do not expressly teach said print information comprising the number of copies to be printed and the media to be printed on. However, the Examiner takes Official Notice that indicating these in a customer print job order is old and well known in the art. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow and PR Newswire to include said print information comprising the number of copies to be printed and the media to be printed on in order to provide the print service with a complete customer order.

Claims 75-81 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chabrow in view of PR Newswire, Goldberg and Official Notice.

Regarding claims 75 and 76, Chabrow teaches a method of printing, said method comprising accessing a home page of a print service through the Internet.

Chabrow does not expressly teach:

sending a cost request from a user through the Internet to the print service, the cost request corresponding to a request for an estimate of a cost of a print job, the cost request including first data about the print job;

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generating a cost estimate in dependence upon the stored cost request, sending the cost estimate through the Internet to the user, the cost estimate including identification data and including the estimate of the cost of the print job;

when the user receives and approves the cost estimate, sending the identification data and second data about the print job from the user through the Internet to the print service, the second data including print data to be recorded on recordable media.

However, Goldberg teaches a method of providing a customized product to a user over the Internet, including the steps of receiving a request for a quote and transmitting a cost estimate to the user in response to the request (Abstract; and col. 5, lines 25-27). At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow to include the teaching of Goldberg in order to provide customers with an estimated cost for their custom print job. Thus, customers would be permitted to compare vendors according to price.

Note neither Chabrow nor Goldberg teach when the cost request is received by the print service, storing the cost request. However, the Examiner takes Official Notice that storing service order price information in a file is old and well known in the art. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow and Goldberg to include when the cost request is received by the print service, storing the cost request in order to process the request at a later time.

Chabrow further teaches: when the second data and the identification data are received by the print service, storing the print data; storing the print data in the final form; outputting the print data in the final form to a printing location; recording the print data in the final form on the

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recordable media at the printing location; and receiving the recordable media bearing the print data.

The combination of Chabrow and Goldberg do not expressly teach when the stored print data is not in a final form, performing a first editing of the stored print data, the first editing being performed by an editor and not by the user. However, PR Newswire teaches a system for collaboratively editing documents over the Internet. At the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow and Goldberg to include the teachings of PR Newswire because including an editor at said printing agency having access to software and hardware to monitor, evaluate and modify said document created by said customer at said user terminal and to store said modified document in a second memory at said printing agency would enable the customer to improve the quality of their documents.

Regarding claim 77, Chabrow, Goldberg and PR Newswire teach all the limitations discussed under claim 76. Chabrow further teaches the cost request including a name of the user, the printing location, and a type of recordable media of the print job. Chabrow does not expressly teach, a number of pages of the print job, a number of copies of the print job, a type of binding of the print job. However, the Examiner takes Official Notice that these are common parameters that are indicated by a customer when ordering a print job. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow, Goldberg and PR Newswire to include a number of pages of the print job, a number of copies of the print job, a type of binding of the print job in order to enable customers to provide complete order information.

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Regarding claim 78, Chabrow, Goldberg and PR Newswire teach all the limitations discussed under claim 77. Chabrow further teaches the printing location corresponding to a selected printing location selected from among a plurality of available printing locations, said outputting of the print data to the printing location corresponding to outputting the print data through the Internet to the printing location. The combination of Chabrow, Goldberg and PR Newswire does not expressly teach the selected printing location being the printing location geographically nearest to the user. However, the Examiner takes Official Notice that providing a custom item to a user based on the user's location is old and well known in the art. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify combination of Chabrow, Goldberg and PR Newswire to include the selected printing location being the printing location geographically nearest to the user. This would enable the printing service to provide the print product to the customer at the most convenient location possible.

Regarding claim 79, Chabrow, Goldberg and PR Newswire teach all the limitations discussed under claim 78. The combination of Chabrow and Goldberg does not expressly teach:

after the editor performs the first editing of the print data, sending the edited print data through the Internet to the user;

when the user receives the edited print data, revising the print data, said revising being performed by the user and not by the editor;

sending the revised print data from the user through the Internet to the print service; and
performing an additional editing of the print data to place the print data in the final form, the additional editing being performed by the editor and not by the user.

However, PR Newswire teaches a system for enabling a plurality of users to collaboratively edit documents over the Internet. At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow and Goldberg to include the teachings of PR Newswire in order to enable customers to improve the quality of their documents.

Regarding claim 80, Chabrow further teaches storing of the print data corresponding to storing the print at the print service. The combination of Chabrow, Goldberg and PR Newswire does not expressly teach storing the cost request corresponding to storing the cost request at the print service. However, the Examiner takes Official Notice that storing service order price information in a file is old and well known in the art. Therefore, at the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow and Goldberg to include when the cost request is received by the print service, storing the cost request in order to process the request at a later time.

Regarding claim 81, Chabrow, Goldberg and PR Newswire teach all the limitations discussed under claim 75. The combination of Chabrow and Goldberg does not expressly teach:

after the editor performs the first editing of the print data, sending the edited print data through the Internet to the user;

when the user receives the edited print data, revising the print data, said revising being performed by the user and not by the editor;

sending the revised print data from the user through the Internet to the print service; and
performing an additional editing of the print data to place the print data in the final form, the additional editing being performed by the editor and not by the user.

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However, PR Newswire teaches a system for enabling a plurality of users to collaboratively edit documents over the Internet. At the time of Applicant's invention, it would have been obvious to one of ordinary skill in the art, to modify Chabrow and Goldberg to include the teachings of PR Newswire in order to enable customers to improve the quality of their documents.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Kaydo, C. "Push printing online" Sales & Marketing Management, Vol. 152, No. 6 (June 2000) p. 20; Dyson, P.E. "Invasion of the Dot-Coms: E-Commerce Hits the Graphic Arts" The Seybold Report on Publishing Systems (November 29, 1999).

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tim Brown whose telephone number is (571) 272-0773. The examiner can normally be reached on Monday - Friday, 8am - 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on (571) 272-0902. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tim Brown
Examiner
Art Unit 1648

tb


Jeffrey A. Smith
Primary Examiner